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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/809,715      | 03/14/2001  | Theodore S. Jardetzky | AL-8                | 5680             |

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HESKA CORPORATION  
INTELLECTUAL PROPERTY DEPT.  
1613 PROSPECT PARKWAY  
FORT COLLINS, CO 80525

EXAMINER

ALLEN, MARIANNE P

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1631

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/809,715

Applicant(s)

JARDETZKY ET AL.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-25, 27-33, 35-40 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-25, 27-33, 35-40, 42-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's arguments filed 1/28/05 have been fully considered but they are not persuasive.

Claims 26, 34, and 41 have been cancelled. Claims 45-47 have been newly added.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24-25, 33, 39, and 44-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

At least claims 24-25, 33 and 39 recite “computer program means.” Applicant points to basis on page 143, lines 3-21. While computer programs are disclosed, the specification does not disclose the concept or use the term “means.” Applicant must intend this “means” limitation to differ from a “computer program” or they would not have put it in the claims. However, this is not contemplated by the originally filed specification.

It is maintained that there is no contemplation in the specification of a method requiring producing a crystal from a complex with the cited sequence homology characteristics (see claims

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28, 36, and 42) and having the stated spacegroup characteristics (see claims 45-47). Applicant has pointed to pages 136 and 137 of the specification. However, this is talking about the properties of a MODEL and not the properties of the crystal used to develop the model.

Claims 28-30, 36, 38, 42 define the first three-dimensional model by obtaining atomic coordinates following crystallization. It is maintained that there is no basis for such a generic concept. The specification does not disclose nor contemplate producing models having a root mean square deviation of less than 10 angstroms from the coordinates in Table 1 by such crystallization methods. While the particular coordinates in Table 1 may have been found this way, the first model of the claims is not limited to this and the specification does not contemplate designing models that meet these criteria from crystals produced by the recited methods.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25, 27-33, 35-40, and 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite “interact” and “interaction.” The specification provides no clear definition of what is intended by these terms and there does not appear to be an art understood definition for these terms. That is, it is not known what would be required to meet this claim limitation. Applicant points to page 144, lines 5-9, but this is not a limitation of the claims nor does it provide an art understood definition for these terms.

***Claim Rejections - 35 USC § 103***

Claims 23-25, 27, 32-33, 35, 37, 39-40, 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freimuth (US 2003/0027338 A1).

This rejection is maintained for reasons of record.

Applicant's arguments are not persuasive. Following the line of logic set forth, supplying new operands to a calculator (2 and 3 rather than 1 and 6) would result in a different method of addition. The method of addition using a calculator programmed with this functionality remains the same and the calculator operates in the same way with new input even though  $2 + 3 = 5$  and  $1 + 6 = 7$ . Applicant refers to *In re Bernhart and Fetter*, but they have not programmed a machine in a certain new and unobvious way. The claims are limited to conventional and well known software for constructing three-dimensional models and determining compounds that interact with a site. The only thing that has changed is the atomic coordinates as input.

Again, the claimed invention uses known software to solve a known problem in a conventional manner. The instant specification acknowledges known prior art computer modeling techniques. Neither the specification nor the claims set forth any special, non-obvious modifications to the known, conventional software and method steps.

***Conclusion***

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
Marianne P. Allen  
Primary Examiner  
Art Unit 1631  
4/14/05

mpa